

REMARKS

In the Office Action dated February 22, 2005, the Examiner indicated that claims 1-14 were rejected. Claims 1-9 and 12-14 remain in this application. Claims 10-11 are canceled herein. No new matter is introduced as a result of these amendments, support for which is found within the specification as filed. Applicants respectfully submit that the Examiner's rejections of claims 1-9 and 12-14 as set forth in the Office Action are overcome, and the claims as amended are allowable over the cited art for the reasons set forth below.

Applicants thank the Examiner for approving the amendments to the drawings and the title of the invention.

A. Claim Rejections - 35 U.S.C. § 103(a)

1. 35 U.S.C. § 103 – *Gotanda* in view of *Makela*

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Application Publication No. 2002-232769 A filed by Gotanda (hereinafter "*Gotanda*") in view of U.S. Patent Application Publication No. 2003/0157959 A1 filed by Makela et al. (hereinafter "*Makela*"). Having reviewed the Examiner's remarks, Applicants respectfully disagree with the Examiner's reading of the disclosures in *Gotanda* and *Makela* and submit that *Gotanda* and *Makela*, alone or in combination, fail to teach or disclose various claim limitations of claims 1-9 and 12-13.

As amended, claim 1 recites, in pertinent part:

1. A portable camera device capable of operation with a host platform, the portable camera device comprising:
a housing;
a USB plug integrally adapted to the housing of the portable camera device to facilitate direct coupling of the portable camera device via the USB plug to a USB socket of the host platform;

(emphasis added). Claims 12 and 14 also include corresponding claim limitations as presented above.

Applicants respectfully reiterate that the present application describes, and claim 1 requires, among other things, a portable camera device having a USB plug integrally adapted to the housing of the device (i.e., there is no captive USB cable), *and* this integrated USB plug facilitates direct coupling of the portable camera device to a USB socket of a host platform via the USB plug (i.e., there is no cable between the integrated USB plug of the portable camera device and the host platform). *See, e.g.*, Figures 2 and 2A; page 14, lines 17-24.

The Examiner agrees that *Gotanda* does not disclose a camera having a USB plug integrally adapted to the housing of the portable camera to facilitate direct coupling of the camera via the USB plug to a USB socket of a host platform, as required by the claims. *Makela* is then cited for the proposition that it remedies these deficiencies. The Examiner further suggests that it is obvious to modify *Gotanda* to come up with a camera device that includes an integrated USB plug to facilitate direct coupling of the camera via the USB plug to a USB socket of a host platform, and that *Makela* provides the motivation to do so. Applicants respectfully disagree.

First of all, Applicants respectfully submit that *Makela* fails to remedy the deficiencies of *Gotanda*. The reason is that, among other things, *Makela* (like *Gotanda*) also never discloses a portable device having a USB plug integrally adapted to the device's housing to facilitate *direct coupling* of the portable device via the USB plug to a USB socket of a host platform. Figures 8 and 9 in *Makela*, cited by the Examiner, each shows a charger plug for connecting the device described therein to an electrical charging system so that the device can be recharged for power. *See* paragraphs 0038 and 0039 on pages 3 and 4. The Examiner has not identified any disclosure in *Makela* that teaches direct coupling of a portable device to a host platform by way of a USB plug that is integrally adapted to the

housing of the portable device. Claims 14, 19 and 23 in *Makela*, also cited by the Examiner, likewise fail to disclose these limitations claimed in the present application.

There is only one paragraph in which USB is discussed in *Makela*. In describing Figure 4, *Makela* states that “Figure 4 illustrates an optional *cable connection* using an interface module 11 for direct connection from the server 10 to a personal computer or the like” (emphasis provided) and that the connection “can be a universal serial bus (USB), or similar connection ...”. See paragraph 0035. Thus, *Makela* teaches that a USB cable be used to connect the device described therein to a personal computer. As such, *Makela* actually *teaches away* from the invention claimed in claim 1 of the present application, which is expressly directed to a portable camera device that includes an integrated USB plug and uses direct USB plug to USB socket coupling – and *not* by using a USB cable – to connect the portable device to a host platform.

Figure 4 and its associated description in paragraph 0035 of *Makela* also confirm that the charger plug described in *Makela* is not a USB plug. As discussed above, *Makela* teaches that interface module 11 can be a USB cable interface, while charger plug 12 connects the device to an electrical charging system so that the device can be recharged for power. Figure 4 clearly shows that interface module 11 and charger plug 12 are two separate and distinct components of the device described in *Makela*. A skilled artisan would not understand the charger plug in *Makela* to be a USB plug.

In addition, Applicants respectfully submit that there is no showing of motivation for a skilled artisan to combine the teachings in *Gotanda* and *Makela* to begin with. The law is clear that, before prior art references can be combined, the Examiner must show some suggestion or motivation found in the art to make the combination. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998). “It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the

prior art, to combine the elements.” *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). Nor is the fact that references *can* be combined sufficient to meet this criterion. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Moreover, the fact that the combination would be well within the ordinary skill in the art, by itself, is insufficient to meet this criterion. *Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999). The Examiner needs to show the additional step of how this knowledge of the skilled artisan leads to the suggestion or motivation.

The Examiner points to element 65 in Figure 4 of *Gotanda* for the proposition that *Gotanda* teaches image data is formatted by the *Gotanda* device into a compatible file format for the host platform. Applicants respectfully traverse. The Examiner has not specifically identified any disclosure in *Gotanda* that teaches formatting image and/or audio data in a standard file format compatible with the host platform, which is another claim limitation of claim 1. Without more, element 65 of *Gotanda* in and of itself cannot be considered to teach or disclose this claim limitation.

For at least the foregoing reasons, a skilled artisan at the time of the present invention would not be motivated to combine *Gotanda* and *Makela* to come up with the claimed invention as suggested by the Examiner. As such, *Gotanda* and *Makela*, whether alone or in combination, do not render obvious claims 1 and 12 of the present application. Thus, Applicants respectfully submit that claims 1 and 12 and all pending claims dependent therefrom, including claims 2-9 and 13, are patentable over the cited references.

Applicants further address several other rejections of the Examiner as follows.

As for claim 2, Applicants respectfully submit that element 15 in Figure 1 of *Gotanda* is a removable memory card and as such does not teach a non-volatile memory that is integrally formed with a digital camera, as is expressly required in claim 2.

As for claim 3, Applicants respectfully submit that element 46 in Figure 2 of *Gotanda* is a USB port, not a USB plug integral to the camera housing. Moreover, the port is located on a base or cradle for the camera rather than on the camera itself. Thus, *Gotanda* does not teach or disclose a USB plug integrally adapted to the housing of a portable camera device that is capable of coupling to a USB port of the host platform. As discussed above, *Makela* does not remedy these deficiencies of *Gotanda*.

As for claim 12, for the same reasons as set forth above with respect to claim 1, Applicants respectfully submit that *Gotanda* fails to teach or disclose a method for capturing image and/or audio data using a portable camera device that includes a housing and a USB plug integrally adapted to the housing to facilitate direct coupling of the portable camera device via the USB plug to a USB socket of the host platform. Again, *Makela* does not remedy these deficiencies.

In view of the foregoing, Applicants respectfully submit that claims 1-9 and 12-13 of the present application are patentable over *Gotanda* and *Makela*, alone or in combination.

2. 35 U.S.C. § 103 – *Foster* in view of *Makela*

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0145507 A1 filed by Foster (hereinafter “*Foster*”) in view of *Makela*. Having reviewed the Examiner’s remarks, Applicants respectfully disagree with the Examiner’s reading of the disclosures in *Foster* and *Makela* and submit that *Foster* and *Makela*, alone or in combination, fail to teach or disclose various claim limitations of claim 14. Applicants respectfully submit that *Foster* fails to teach or disclose the use of a digital camera having a housing and a USB plug integrally adapted to the housing to facilitate direct coupling of the digital camera via the USB plug to a USB socket of a host platform, as required by claim 14 as amended herein.

As amended, claim 14 recites, in pertinent part:

14. A method of authenticating an operator seeking access to information on a storage medium, comprising the steps of:
capturing image and/or audio identification data via a digital camera, ***said digital camera having a housing and a USB plug integrally adapted to the housing to facilitate direct coupling of the digital camera via the USB plug to a USB socket of a host platform;***

(emphasis added).

As discussed above, the present application describes a portable camera device that has a housing and a USB plug integrally adapted to the housing to facilitate direct coupling of the device via the USB plug to a USB socket of a host platform. The present application also teaches that the portable camera device can be used to accept identification information for authentication purposes. *See, e.g.,* page 15, line 21 to page 16, line 10. Claim 14 is directed to a method implementing such an authentication scheme using the digital camera described in the present application.

The Examiner agrees that *Foster* does not disclose a camera having a USB plug integrally adapted to the housing of the portable camera to facilitate direct coupling of the camera via the USB plug to a USB socket of a host platform, as required by claim 14. *Makela* is then cited for the proposition that it remedies these deficiencies. The Examiner further suggests that it is obvious to modify *Foster* to come up with a camera device that includes an integrated USB plug to facilitate direct coupling of the camera via the USB plug to a USB socket of a host platform, and that *Makela* provides the motivation to do so. Applicants respectfully disagree.

First, Applicants respectfully submit that there is no disclosure in *Makela* that teaches direct coupling of a portable device to a host platform by way of a USB plug that is integrally adapted to the housing of the portable device. As discussed in detail above in Section A.1, Figures 8-9 show a charger plug and not an integrated USB plug that facilitates direct coupling of a portable device to a host platform, as required in claim 14 in this application. Claims 14, 19 and 23 in *Makela* also fail to disclose this limitation in claim 14 in this

application. Furthermore, there is no showing of motivation for a skilled artisan to combine the teachings in *Foster* and *Makela* in the first place. Thus, for the same reasons described above, *Makela* fails to remedy the deficiencies of *Foster*.

For at least the foregoing reasons, Applicants respectfully submit that claim 14 is patentable over *Foster* and *Makela*, whether alone or in combination.

B. Conclusion

Applicants respectfully assert that all of the rejections to the pending claims are overcome, and that claims 1-9 and 12-14 are patentable over the cited art of record. If prosecution of this application can be expedited through a telephone interview, the Examiner is invited to call the undersigned attorney at the number below. Otherwise, early notification of allowance of claims 1-9 and 12-14 is earnestly requested.

Attached hereto is a petition for extension of time for three (3) months. In connection therewith, the Commissioner is hereby authorized to charge the fee required under 37 CFR § 1.136(a) to White & Case LLP Deposit Account No. 23-1703. Applicants are unaware of any other fees due at this time. However, if other fees are due for this extension or any other matter concerning this response, the Commissioner is authorized to charge the fees to the above-listed Deposit Account.

Respectfully submitted,



Warren S. Heit (Reg. No. 36,828)

White & Case LLP

1155 Avenue of the Americas

New York, NY 10036-2787

(650) 213-0300

Dated: August 22, 2005